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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,925	07/23/2001	Ashar Aziz	55218-0511	4906

7590 08/26/2004

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EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/911,925

Applicant(s)

AZIZ ET AL.

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt of the Preliminary Amendment of the specification filed March 22, 2004 is acknowledged. Claims 1-41 remain unchanged and are presented to be examined upon their merits.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to a technological art, environment or machine, the claim is not statutory. The recitations in at least the claims 1 and 19, are directed to merely human mental computation and/or processes that can be performed by a person manually, and thus is considered nothing more than an abstract idea which is not useful art as contemplated by the constitution [see Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD Pat. App & Inter 2001) (Unpub)]\*. Also note MPEP 2106 IV 2(b). The abstract Idea does not become a technological art by reciting in the preamble, for example, "a computer-implemented method..." because the recitation in the body of the claim(s) manipulates an abstract idea without producing a useful, concrete and tangible result.

\*Even though Bowman is not precedential, It can be cited for its analysis.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the phrase “may be” in the limitation “may be dynamically selected and de-selected” is indefinite because it has both positive and negative connotations to the elements in the claim(s), which renders the scope of the claim(s) unascertainable. What is meant in the phrase by “dynamically”? “...selected and de-selected...” is confusing because it sounds like you can do both at the same time. What is the difference between the usage data and the value data? What constitutes a “base line resource configuration”?

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crooks et al (US 5,930,773).

Re claims 1-7, 19-25, 37, 39-41: Crooks discloses a method for determining an amount to billed to a customer for the use of resources, the method of comprising the computer-implemented steps of:

determining usage data that indicates use during a specified period of time (see Crooks, Abstract), of a set or one or more resources that can be selected or de-selected from a plurality of resources 38-44 (see Crooks, fig. 4, col. 9, ll. 29+); and

determining the amount to be billed to the customer based upon the usage data and value data that indicates value provided by each resource from the set of one or more resources (see Crooks, fig. 37, 38A-38B, col. 16, ll. 54+),

Re claim 8 and 26, wherein the set of one or more resources comprise a baseline resource configuration (see Crooks, fig. 37, 38A-38B, col. 16, ll. 54+),

Re claims 9 and 27, wherein the set of one or more resources comprise a virtual server farm (see Crooks, figs. 3 and 4, col. 7, ll. 10-22; col. 8, ll. 36+; and col. 8, ll. 58+; col. 9, ll. 29+),

Re claim 10 and 28, wherein the plurality of resources includes one or more computing resources (see Crooks, figs. 3 and 4, col. 7, ll. 10-22; col. 8, ll. 36+; and col. 8, ll. 58+; col. 9, ll. 29+),

Re claim 11 and 29, wherein one or more computing resources includes one or more processors (see Crooks, figs. 3 and 4, col. 7, ll. 10-22; col. 8, ll. 36+; and col. 8, ll. 58+; col. 9, ll. 29+),

Re claims 12-15 and 30-32 plurality of resources includes one or more storage (see Crooks, figs. 3 and 4, col. 7, ll. 10-22; col. 8, ll. 36+; and col. 8, ll. 58+; col. 9, ll. 29+),

Re claim 16 and 34, wherein the plurality of resources includes one or more computer software resources (see Crook, fig. 4, col. 6, ll. 25+),

Re claim 17 and 35, wherein the plurality of resources includes one or more communications link resources (see col. 7, ll. 10+; col. 8, ll. 58+; and c)

Re claim 18 and 36, wherein the one or more communications link resources includes one or more internet connections (see col. 8, ll.

In claims 20-25, Crooks discloses a software program executable on the computer system which all the steps of the limitations of the claims, but fails to disclose that the steps are performed a computer readable medium. Floppy-discs, CDs and magnetic tapes are notoriously old and well known computer readable medium and storage devices that are commonly used to store software programs that can be downloaded onto a computer system. One of ordinary skill in the art would have recognized the convenience and flexibility of using one of the aforementioned computer readable medium to remotely store the software program and to carry along and use at various locations. Thus an artisan of ordinary skill in the art would have sought to use the computer readable media for these advantages and reasoning being within the skill of one of ordinary art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF  
August 20, 2004



Daniel S Felten  
Examiner  
Art Unit 3624

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